



UNITED STATES PATENT AND TRADEMARK OFFICE

DEC 13 2007

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

James S. Keddie, Ph.D.  
BOZICEVIC, FIELD & FRANCES LLP  
ARENA PHARMACEUTICALS, INC.  
1900 UNIVERSITY AVENUE  
SUITE 200  
EAST PALO ALTO, CA 94303

In re Application of:

ADAMS et al.

Serial No.: 10/523,100

Filed: January 31, 2005

Attorney Docket No.: AREN-27  
(27.US2.PCT)

:  
:  
:  
:  
:

PETITION DECISION

This is in response to the petition under 37 CFR § 1.181, filed September 20, 2007, requesting that the Notice of Non-Responsive Amendment of September 4, 2007 be withdrawn.

## BACKGROUND

This application was filed as a national stage application under 35 USC 371 of PCT/US03/23296 and, as such, is eligible for unity of invention practice.

A review of this application reveals that the examiner mailed a restriction requirement on March 3, 2006 y. The examiner divided claims 85-121 into 14 Groups and indicated that the Groups lacked unity of invention and therefore were properly restrictable under PCT Rule 13.1. The Groups of the Restriction requirement were set out by the examiner as follows:

- I. Claims 85-96, drawn to a method of identifying a modulator of a RUP41 GPCR.
- II. Claim 97, drawn to a process for making a modulator of a RUP41 GPCR.
- III. Claims 98-100 and 104, drawn to a modulator.
- IV. Claims 101 and 102, drawn to a method of modulating the activity of a RUP41 GPCR.
- V. Claim 103, drawn to a method of preparing a composition.
- VI. Claims 105-109, drawn to a method of cardioprotection.
- VII. Claim 110, drawn to a method of making a knockout mouse or rat.
- VIII. Claims 111 and 112, drawn to a method of using the knockout mouse or rat.
- IX. Claims 113-115, drawn to an isolated rat RUP41 polynucleotide, a vector, and a host cell.
- X. Claim 116, drawn to a GPCR fusion protein comprising a RUP41 amino acid

sequence.

- XI. Claim 117, drawn to a method of identifying a ligand of a RUP41 GPCR.
- XII. Claims 118 and 119, drawn to a method of radioimaging.
- XIII. Claim 120, drawn to a non-human mammal transgenic for a human RUP41 GPCR.
- XIV. Claim 121, a method of using the tansfenic [*sic*] non-human mammal.

The examiner further required a restriction between the claimed amino acid sequences (i.e., SEQ ID's 1, 2, 3, 4 and 5) indicating that the polypeptides having the SEQ ID No's lacked unity of invention and additionally required an election of species between the diseases of claims 89-91; the examiner indicating that the species lacked a special technical feature and thus lacked unity of invention.

In response to the Restriction requirement set forth by the examiner on March 3, 2006, applicants filed a reply on September 26, 2006 which included the election of Group I and SEQ ID NO. 3 with traverse. Applicants' reply further included amendments to the claims, the addition of new claims 122-131 and arguments traversing the restriction requirement.

The examiner mailed a non-final Office action on December 21, 2006. In this Office action, the examiner considered applicants' traversal of the restriction requirement; however, the examiner indicated that applicants' arguments were not persuasive and thus rendered the restriction requirement FINAL. The examiner did however, join new claims 122-131 with Group I for examination.

In response, applicants filed an amendment and remarks on June 8, 2007. In this response, applicants cancelled claims 85-131 and added new claims 132-152.

On September 4, 2007, the examiner set forth a Notice of Non-Responsive Amendment. In this Notice, the examiner indicated that:

The amendment filed on 06/08/2007 canceling all claims drawn to the elected invention and presenting only new claims drawn to non-elected inventions is non-responsive (MPEP § 821.03). Moreover, the amendment does not show the specific support for each of the newly added claims.

In response to the Notice of Non-Responsive Amendment of September 4, 2007, applicants filed a petition under 37 CFR § 1.181 on September 20, 2007, requesting that the Notice of Non-Responsive Amendment of September 4, 2007 be withdrawn.

## DISCUSSION

The petition and the file history have been carefully considered.

The MPEP states that:

An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered. Such an amendment is nonresponsive. Applicant should be notified by using form paragraph 8.26.

¶ 8.26 Canceled Elected Claims, Non-Responsive

The amendment filed on [ 1 ] canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). *The remaining claims are not readable on the elected invention because [ 2 ]* (MPEP § 821.03, emphasis added)

Thus, in situations where an amendment is submitted by applicants canceling all claims directed toward the elected invention, and a Notice of Non-responsive amendment is submitted by the examiner, the MPEP *requires* an explanation of why the remaining claims (in the present instance, claims 132-152) do not read on the elected invention. However, the examiner provided no such reasoning and therefore did not fulfill the requirement of MPEP § 821.03, hence rendering the Notice incomplete.

Applicants argue that the Notice of Non-Responsive Amendment submitted by the examiner on September 4, 2007 was in error because:

While the scope of the new and old claim sets may be different, the Applicants submit that both claim sets are directed to a method of identifying a modulator of RUP41. As such, it is the Applicants' belief that both claim sets are directed to elected subject matter. (p. 1, Petition)

Applicants further argue that their response of June 8, 2007 set forth support for the addition of new claims 132-152 (p. 2, Petition). New Claim 132 is set forth below.

132. (New) A method comprising:

- (a) contacting a candidate compound with a G protein-coupled receptor comprising an amino acid sequence having at least 90% identity to SEQ ID NO:3, wherein said GPCR is present on a cell or isolated membrane thereof;
- (b) determining the ability of the compound to modulate the G protein-coupled receptor; and
- (c) determining if said compound has cardioprotective activity.

Claim 88, part (h) which was examined in the first Office action on the merits, recites a similar limitation as Claim 132(a) of "...an amino acid sequence of a G-protein coupled receptor having at least 90% identity to SEQ ID NO 2, SEQ ID NO:3 or SEQ ID NO 5."

Thus, claims 132-147 are directed toward the same subject matter as the elected invention and should be entered and examined.

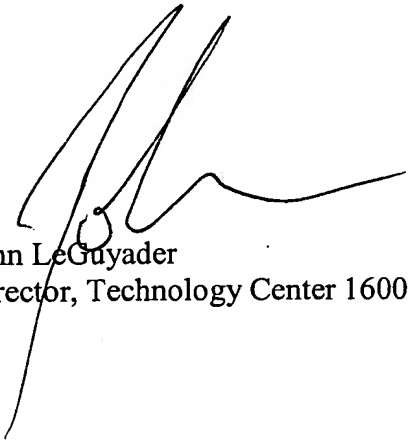
## DECISION

The petition under 37 CFR § 1.181, filed September 20, 2007, requesting that the Notice of Non-Responsive Amendment of September 4, 2007 be withdrawn is **GRANTED**.

The incomplete Notice of Non-Responsive Amendment dated June 08, 2007 is hereby withdrawn.

The application will be forwarded to the examiner to reconsider the amendment filed by applicants on June 8, 2007 and to examine at least claims 132-147 which are directed toward the elected invention. If the examiner withdraws any claims on the merits, an explanation of why those claims are not directed toward the elected invention must be incorporated in the next communication to applicants.

Should there be any questions about this decision please contact Quality Assurance Specialist Julie Burke, by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0512 or by facsimile sent to the general Office facsimile number, 571-273-8300.



John LeGuyader  
Director, Technology Center 1600